

## **REMARKS**

### **I. General**

Claims 1-26 are pending in the present application. Claim 15 has been amended. The outstanding issues in the current Office Action are as follows:

- Claims 1-21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. 2004/0177321 to Brown et al. (hereinafter *Brown*) in view of Dreamweaver TechNote 16416, “How to make an inherited region uneditable” (hereinafter *Dreamweaver*);
- Claims 22-24, and 26 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,061,697 to Nakao (hereinafter *Nakao*) in view of *Brown*; and
- Claim 25 is rejected under 35 U.S.C. § 103(a) as being unpatentable over *Nakao* in view of *Brown*, and further in view of U.S. Patent No. 5,752,643 to Judson (hereinafter *Judson*).

In response, Applicant respectfully traverses the outstanding claim rejections and requests reconsideration and withdrawal in light of the remarks presented herein.

### **II. Amendments to the Claims**

Claim 15 has been amended to more particularly point out and distinctly claim certain inventive subject matter. This amendment is not being made to overcome any rejection of record. Support can be found in the specification generally and specifically at paragraph [0028]. No new matter has been added.

### **III. Improper Claim Rejections**

Applicant respectfully points out that the Examiner has made several contradictory statements in the current Office Action that are material to the rejections of record. For example, the Examiner has stated that *Brown* “teaches a method of inserting XML restriction

tags into [a revised document],” while simultaneously admitting that *Brown* “does not explicitly teach a method where the restriction tags are inserted into [a revised document] . . . .” *Office Action*, page 3. Moreover, the Examiner has not responded to any of Applicant’s previous arguments with respect to the patentability of claims 22-25. *See e.g., Amendment Accompanying Request for Continued Examination* (filed April 27, 2006). As a result, the Examiner has not clearly articulated all claim rejections early enough in the prosecution process so that Applicant may have the chance to provide evidence of patentability and otherwise respond at the earliest opportunity. *See* M.P.E.P. § 706.

Therefore, Applicant respectfully requests that the Examiner clearly set forth specific grounds for rejection or reasons for allowance of all pending claims in a subsequent, non-final office action, so that Applicant may have a full and fair opportunity to explore the patentability of these claims.

#### **IV. Claim Rejections Under 35 U.S.C. § 103(a) Over *Brown* in view of *Dreamweaver***

Claims 1-21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Nakao* in view of *Brown*. Applicant traverses the rejection and asserts that the claims are allowable, at least, for the reasons stated below.

To establish a prima facie case of obviousness under 35 U.S.C. § 103(a), three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the references’ teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *See* M.P.E.P. § 2143. Applicant asserts that the rejection does not satisfy the basic criteria.

##### **A. Lack of All Claimed Limitations**

###### **1. Independent Claims 1 and 8**

Claim 1 recites, in part, “inserting one or more restriction tags into said revised document delimiting non-editable content defined by one or more of said plurality of tags,”

and claim 8 recites, in part, “code for inserting a prohibition label in said modified document around each instance of non-editable content as defined by said one or more descriptive labels.” Applicant respectfully asserts that neither *Brown* nor *Dreamweaver*, taken alone or in combination, teach or suggest these limitations.

As Applicant has repeatedly pointed out, *Brown* does not disclose inserting restriction tags into a revised document. See e.g., *Amendment Accompanying Request for Continued Examination*, page 10 (filed April 27, 2006). Rather, *Brown* teaches the use of two distinct files: a bounding file, and an XML file. *Brown*, paragraphs [0060] and [0094]. According to *Brown*, the bounding file contains all editing restrictions to be applied to the XML file. *Id.* Therefore, *Brown*’s editing restrictions are inserted into a separate, bounding file, and not directly into a file to be edited—*i.e.*, a revised document, as claimed.

*Dreamweaver* does not disclose inserting restriction tags into a revised document either. The Examiner has incorrectly stated that *Dreamweaver* “teaches the use of nested templates with editable and non-editable regions delimited by tags that are inserted into a revised document . . . .” *Office Action*, page 3. However, *Dreamweaver* only discloses placing a template code into a nested template, and not into a revised document—*i.e.*, an instance of the nested template. In fact, *Dreamweaver* teaches that:

6. *Within the nested template*, locate in the code the editable region from the base template you wish to lock . . . [and]
7. *Add the following [template] code* to the editable region [of the nested template]. . . .

*Dreamweaver*, page 3 (emphasis added). Therefore, similarly to *Brown*, *Dreamweaver*’s editing restrictions are inserted into a separate, nested template, and not directly into a template instance to be edited—*i.e.*, a revised document, as claimed.

Applicant further points out that any interpretation of *Dreamweaver*’s nested template as being a revised document would be entirely inconsistent with other limitations recited in claims 1 and 8. For example, claim 1 recites, in part, “restricting edit functions of a page editor editing said revised document.” Thus, according to claim 1, editing restrictions are invoked with respect to the document where restriction tags are inserted—*i.e.*, the revised

document. In contrast, according to *Dreamweaver*, editing restrictions are placed only upon *instances* of a nested template, even though the nested template is the document where template codes are inserted. *Dreamweaver*, pages 2-3. Thus, *Dreamweaver*'s nested template cannot be a revised document, as claimed.

In sum, neither *Brown* nor *Dreamweaver* teach or suggest all the limitations of claims 1 and 8. Consequently, the combination of *Brown* and *Dreamweaver*, even if proper, fails to teach or suggest all of the limitations of claims 1 and 8. Accordingly, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 103(a) rejection of record with respect to claims 1 and 8.

## 2. Independent Claim 15

Claim 15 recites, in part, "inserting one or more restriction markup tags in said substitute Web document demarcating non-editable content as defined by one or more of said plurality of markup tags." At least for the same reasons presented above with respect to claims 1 and 8, Applicant respectfully asserts that neither *Brown* nor *Dreamweaver* teach or suggest this limitation.

Claim 15, also recites, as amended, "displaying said non-editable content to provide context for an editable portion of said Web document." Applicant respectfully points out that, according to *Dreamweaver*, the result of inserting a template code into a nested template is that the symbol "@@" replaces non-editable content. *See Dreamweaver*, second figure. Thus, even if the Examiner incorrectly contends that *Dreamweaver*'s nested template meets the claimed Web document, Applicant respectfully points out that the non-editable content of *Dreamweaver*'s nested template is hidden from the user, and thus it is not displayed to provide context for an editable portion of the template, as claimed.

Therefore, neither *Brown* nor *Dreamweaver* teach or suggest all the limitations of claim 15. Consequently, the combination of *Brown* and *Dreamweaver*, even if proper, fails to teach or suggest all of the limitations of claim 15. Accordingly, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 103(a) rejection of record with respect to claim 15.

3. Dependent Claims 2-7, 9-14, and 16-21

Dependent claims 2-7, 9-14, and 16-21 depend either directly or indirectly from claims 1, 8, and 15, respectively, thus inheriting all the limitations of their respective independent claims. As noted above, the combination of *Brown* with *Dreamweaver* fails to teach or suggest all of the limitations of independent claims 1, 8, and 15. Consequently, the combination of *Brown* with *Dreamweaver*, even if proper, also fails to teach or suggest all of the limitations of dependent claims 2-7, 9-14, and 16-21. Moreover, each of these dependent claims recite additional limitations not taught or suggested by the applied art. Accordingly, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 103(a) rejection of record with respect to claims 2-7, 9-14, and 16-21.

B. Lack of Motivation

Claims 1-21 are also allowable because there is no suggestion or motivation to combine the “meta editor for structured documents” described in *Brown* with the “method for making an inherited editable region uneditable” of *Dreamweaver*. In support for the combination of *Dreamweaver* and *Brown*, the Examiner states that:

[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to combine the templates with editable regions taught by Dreamweaver with the XML bounding DTD with restriction tags taught by Brown, so that the editing GUI would have functionality to control and restrict editing both of HTML (Dreamweaver) and XML (Brown), and so that the user would have the benefit of a simpler way to edit XML files and the application developer would have control over user actions while editing the files . . . .”

First, Applicant respectfully points out that *Brown* alone already provides “a simpler way to edit XML files and the application developer would have control over user actions while editing the files.” *See Brown*, Abstract. As such, adding *Dreamweaver* to *Brown* for the purposes put forth by the Examiner would be superfluous, and thus there would be no discernable benefit in the proposed combination.

Moreover, Applicant respectfully asserts that there is no indication in *Brown* of a need to control and restrict HTML documents. Neither is there any indication in *Dreamweaver* of



a need to control and restrict XML documents. The mere fact that references can be combined does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990), *cited in* M.P.E.P. § 2143.01. In this case, the Examiner is merely stating that *Dreamweaver*'s HTML editor can be combined with *Brown*'s XML editor. However, neither the prior art nor the knowledge available to a person of ordinary skill in the art suggests the desirability of combining *Brown* with *Dreamweaver*. Accordingly, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 103(a) rejection of record with respect to claims 1-21.

**V. Claim Rejections Under 35 U.S.C. § 103(a) Over *Nakao* in view of *Brown***

Claims 22-24, and 26 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Nakao* in view of *Brown*. Applicant traverses the rejection and asserts that the claims are allowable, at least, for the reasons stated below. Applicant also points out that several of the arguments contained herein have been previously asserted, but the Examiner has yet to address them. *See e.g., Amendment Accompanying Request for Continued Examination* (filed April 27, 2006).

**A. Lack of All Claimed Limitations**

**1. Independent Claim 22**

Claim 22 requires "a parsing engine for analyzing a plurality of Web page markup tags . . . ." The Examiner relies solely upon *Nakao* as meeting this limitation. *Office Action*, page 9. However, Applicant respectfully asserts that the term "document elements," as used by *Nakao*, does not refer to "tags." Rather, several passages of *Nakao* describe "document elements" as portions of a document that are subject to being edited. For example, *Nakao* discloses that:

[t]he conventional SGML document managing apparatus uses the check-out/check-in system of *document elements*. It checks out a *document element* according to the request for editing from a worker, and allows the worker to update only the portion in lower hierarchical levels than the checked-out element. When the portion is checked in, it examines the conformance to the DTD of the entire document to maintain the

consistency of the document (this operation is referred to as SGML parsing). *Nakao* at col. 2, lines 20-29 (emphasis added).

Thus, although *Nakao* may teach assigning an instance identifier to a document element, it does not meet the step of “identifying a plurality of Web page markup tags,” as recited in claim 22, because a “document element,” as defined and used in *Nakao*, is not a “tag.”

Applicant respectfully reminds the Examiner that *Nakao* was entitled to be his own lexicographer. *See* M.P.E.P. § 2111.01. Because a definition was provided by *Nakao* for the term “document element,” that definition controls interpretation of that term. *Id.*

The Examiner has previously contended that “[i]t was notoriously well known in the art at the time of the invention that a SGML element was also known as a ‘tag.’” *See* Final Office Action, page 11 (mailed May 5, 2006). However, “elements” are clearly not “tags.” In fact, the difference between tags and elements is basic:

[b]ecause this *basic concept* is so important to understand, I think it bears repeating: *tags* are the letters and numbers between the angle brackets, whereas *elements* are tags *and* anything between the opening and closing tags. JOHN DUCKETT, BEGINNING WEB PROGRAMMING WITH HTML, XHTML, AND CSS 6 (Wiley Publishing, Inc. 2004) (emphasis added).

Therefore, an element is not the same thing as a tag, as has been previously suggested by the Examiner. Moreover, even assuming that *Nakao*’s document element may contain a plurality of tags, identifying a document element is not the same as identifying tags within that document element. Applicant has been unable to find any disclosure in *Brown* that teaches or suggests the aforementioned limitation, and the Examiner has not shown otherwise.

Claim 22 also recites “a list of restriction tags for insertion around said design elements, as defined by one or more of said plurality of Web page markup tags . . . .” The Examiner has previously conceded that *Nakao* did not teach or suggest inserting restriction tags. *See* Final Office Action, page 3 (mailed May 5, 2006). In the current *Office Action*, however, the Examiner states that *Nakao* meets this limitation without citing any portion of the reference in support this argument. Applicant has been unable to find any disclosure in

*Nakao* that teaches or suggests this limitation, and the Examiner has not shown otherwise. Therefore, Applicant respectfully requests that the Examiner identify at least one passage of *Nakao* that is believed to teach or suggest the claimed limitation, or that the rejection of record with respect to claim 22 be withdrawn.

Claim 22 further recites “a plurality of deselectable editing functions, wherein said deselection is responsive to said restriction tags.” The Examiner relies upon *Brown* as teaching or suggesting the aforementioned step of claim 1. *Office Action*, page 9. However, at the passage cited by the Examiner, *Brown* only discloses a meta editor that allows a developer to select an element in a bounding file to be hidden or non-editable when it has a particular value. *Brown* at paragraph [0108]. As such, while *Brown*’s restrictions may be responsive to a developer’s selection, they are not responsive to the reading of a restriction tag. Moreover, as noted above, because *Brown*’s bounding file is not a revised document, *Brown* does not restrict editing by reading tags which are placed in a revised document, as claimed.

Therefore, the combination of *Nakao* and *Brown*, even if proper, does not teach or suggest every limitation of claim 22. Accordingly, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 103 rejection of record with respect to claim 22.

## 2. Dependent Claims 23, 24, and 26

Dependent claims 23, 24, and 26 depend either directly or indirectly from claim 22, thus inheriting all the limitations of that independent claim. As noted above, the combination of *Nakao* and *Brown* fails to teach or suggest all of the limitations of independent claim 22. Consequently, the combination of *Nakao* and *Brown*, even if proper, also fails to teach or suggest all of the limitations of dependent claims 23, 24, and 26. Accordingly, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 103 rejection of record with respect to claims 23, 24, and 26.



B. Lack of Motivation

Applicant further asserts that, in addition to the fact that the combination of *Brown* with *Nakao* does not teach or even suggest all of the claimed limitations, there is no suggestion or motivation to combine these references. The Examiner states that:

[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to apply Brown to Nakao, so that the user would have the benefit of techniques that enable application developers to have some control over what users can do when editing a structured document file . . . .

*Office Action*, page 10. However, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art or its teachings also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990), *cited in* M.P.E.P. § 2143.01. Furthermore, the language of the recited motivation is circular in nature, stating that it is obvious to make the modification because it is obvious to achieve the result—*i.e.*, “it would have been obvious to combine *Brown* with *Nakao* in order to have features of *Brown* combined with *Nakao*’s.” Such language is merely a statement that the references can be combined and does not state any desirability for making the combination. Neither the prior art nor the knowledge available to a person of ordinary skill in the art at the time the invention was made suggest the desirability of the combination, and Applicant asserts that there is no suggestion or motivation to combine *Brown* with *Nakao*. Therefore, the Examiner has not established a *prima facie* case of obviousness under 35 U.S.C. § 103(a). *See* M.P.E.P. § 2143. Moreover, Applicant respectfully asserts that the Examiner is relying on impermissible hindsight in order to piece together the elements of the claims based on knowledge gleaned from Applicants’ disclosure. *See* M.P.E.P. § 2145(X)(A). Accordingly, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 103(a) rejection of record with respect to claims 22-24 and 26.

**VI. Claim Rejections Under 35 U.S.C. § 103(a) Over *Nakao* in view of *Brown* and *Judson***

Claim 25 is rejected under 35 U.S.C. § 103(a) as being unpatentable over *Nakao* in view of *Brown*, and further in view of *Judson*. Applicant traverses the rejection and asserts that the claims are allowable, at least, for the reasons stated below.

**A. Lack of All Claimed Limitations**

The combination of *Nakao* and *Brown* fails to teach or suggest several features required by independent claim 22. For example, the combination of *Nakao* and *Brown* fail to teach or suggest “a plurality of deselectable editing functions, wherein said deselection is responsive to said restriction tags,” “a list of restriction tags for insertion around said design elements, as defined by one or more of said plurality of Web page markup tags,” and “a parsing engine for analyzing a plurality of Web page markup tags.” The Examiner does not rely upon *Judson* as teaching or suggesting these features, and Applicant asserts that *Judson* does not teach or suggest the above-referenced features. Therefore, the combination of *Nakao*, *Brown*, and *Judson* fails to teach or suggest all of the limitations of independent claim 22. Dependent claim 25 depend from claim 22, and thus inherit all the limitations of that independent claim. Consequently, the combination of *Nakao*, *Brown*, and *Judson*, even if proper, also fails to teach or suggest all of the limitations of dependent claim 25. Accordingly, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 103 rejection of record with respect to claim 25.

**B. Lack of Motivation**

Applicant also asserts that, in addition to the fact that the combination of *Brown* and *Nakao* with *Judson* does not teach or even suggest all of the claimed limitations, there is no suggestion or motivation to combine these references. Particularly, *Judson*’s invention relates to methods for enhancing the operation of a client browser by displaying information to the user during the period of time between the linking and the downloading a document via the World Wide Web. *Judson*, Abstract; col. 1, lns 6-9 and 59-64. Information displayed by *Judson* includes advertisements, notices, messages, and the like. *Judson*, col. 2, lns 42-44. Simply put, there is absolutely no reason why a person of ordinary skill in the art would be

motivated to combine the web-browsing method of *Judson* with the document management method of *Nakao* and/or the meta editor for structured documents of *Brown*. Nonetheless, the Examiner argues that:

[i]t would have been obvious . . . to combine Nakao, Brown, and Judson, so that the user would have the benefit of viewing the hidden information instantly, without the added time that would have been required to download the information, and [the] information could be viewed as required by the user.

*Office Action*, page 11. In response, Applicant asserts that neither *Nakao* nor *Brown* teach or suggest presenting a user with “hidden information,” and thus there would be no benefit in “viewing the hidden information instantly” as stated by the Examiner.

Even assuming, *arguendo*, that there would be any benefit in “viewing hidden information instantly” in *Nakao* and/or *Brown*, the Examiner is merely stating that it would be obvious to add *Judson*’s features into *Nakao* and *Brown* in order to have the benefits of *Judson* incorporated into *Nakao* and *Brown*. In other words, the language of the recited motivation is circular in nature, stating that it is obvious to make the modification because it is obvious to achieve the result. Such language is merely a statement that the reference can be modified and does not state any desirability for making the modification. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990), *cited in* M.P.E.P. § 2143.01. Neither the prior art nor the knowledge available to a person of ordinary skill in the art suggest the desirability of the combination, and Applicant asserts that there is no suggestion or motivation to combine *Judson* with *Nakao* and/or *Brown*. Accordingly, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 103(a) rejection of record with respect to claim 25.

## VII. Conclusion

In view of the above, Applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2380, under Order No. M061, from which the undersigned is authorized to draw.

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Respectfully submitted,

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